UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,851	04/12/2001	Wanqian D. Liu	20683000120	8396

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EXAMINER
BOVEJA, NAMRATA

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/834,851	LIU ET AL.
	Examiner	**Art Unit**
	Namrata Boveja	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 April 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *4/12/2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *1/25/2002*.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-21 are presented for examination.

Objections

2.   The abstract of the disclosure is objected to because, the abstract is

partially in the claim format. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –(e) the invention was described in (1) an
> application for patent, published under section 122(b), by another filed in the United
> States before the invention by the applicant for patent or (2) a patent granted on an
> application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined
> in section 351(a) shall have the effects for purposes of this subsection of an application
> filed in the United States only if the international application designated the United States
> and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1-20 are rejected under 102(e) as being anticipated Barnett et al

(6,336,099 hereinafter Barnett).

In reference to claim 1, Barnett discloses a central server configured to

promote products over a computer network comprising: a processor configured

to receive a specification of a promotion for a product from a first computer (col. 4

lines 42-50, col. 6 lines 55-58, col. 8 lines 14-21, and Figure 9), configured to

create an electronic incentive in response to the specification (col. 4 lines 59-62,

col. 8 lines 17-21), configured to transfer the electronic incentive to an application

server (i.e. equivalent to the online service provider in the prior art) across the

computer network, the application server coupled to a merchant server (i.e.

equivalent to the coupon distributor in the prior art) (col. 8 lines 6-13 and Figure 6), configured to receive usage data of the electronic incentive from the application server, the usage data determined in response to a promotion usage condition indicated by the merchant server (col. 7 lines 36-41, col. 10 lines 51-56, and Figure 1), and configured to generate a report in response to the usage data (col. 7 lines 44-51); a memory coupled to the processor (col. 4 lines 50-54), the memory configured to store the electronic incentive (col. 4 lines 54-59), configured to store the usage data (col. 5 lines 28-34), and configured to store the report (col. 7 lines 36-51); wherein data associated with the electronic incentive is transferred from the application server to the merchant server (Figure 1); wherein the merchant server specifies rendering of the data associated with the electronic incentive (col. 7 lines 36-55); and wherein the promotion usage condition is indicated in the merchant server when a user coupled thereto fulfills requirements of the electronic incentive (col. 7 lines 17-20).

4.   In reference to claim 8, Barnett teaches a method for a merchant server coupled to a client system comprising: a processor configured to request promotions from an application server coupled to the merchant server (col. 5 lines 3-7 and Figure1); configured to receive a description of a promotion from the application server (Figure 3), the description including pre-conditions and a user benefit (Figure 3 and 5), configured to transmit the output representation of the description to a client system for display to a user (col. 8 lines 22-33 and Figure 1); configured to receive a selection of at least one item from the client system (col. 9 lines 59-67); configured to transmit the selection of the at least one

item to the application server (col. 10 lines 1-16), configured to receive an

indication that the user is provided with the user benefit from the application

server (col. 7 lines 35-44col. 10 lines 47-53), and configured to store in a log

record that the user is provided with the user benefit (col. 10 lines 51-56); and a

memory coupled to the processor (col. 4 lines 50-54), the memory configured to

store the description of the promotion (col. 4 lines 54-59), configured to store the

selection of at least one item (col. 12 lines 35-54).

5.   In reference to claims 2 and 9, Barnett teaches the central server wherein

the electronic incentive and user benefit comprises an offer selected from the

group: cents off (Figure 5), percent discount, price point, buy X get Y free (col. 12

lines 45-54), solution selling, and promotion content.

6.   In reference to claims 3 and 10, Barnett teaches the central server and the

processor configured to receive the description when the user meets target

criteria of the electronic incentive delivery method selected from the group or

class including: non-targeted, targeted category (col. 6 lines 62-65), targeted

usage (col. 6 lines 62-65), targeted brand, and targeted market (col. 7 lines 45-

51, col. 4 lines 36-40, and Figure 9).

7.   In reference to claims 4 and 5, Barnett teaches the central server wherein

the electronic incentive comprises a tracking code (col. 7 lines 21-35 and Figure

3) and calendar data selected from the group: effective date, expiration date

(Figure 3)

8.   In reference to claim 6, Barnett teaches the central server wherein the

electronic incentive comprises a network computer address (col. 13 lines 58-67

and Figure 4A).

9.   In reference to claim 7, Barnett teaches a central server wherein the

usage from the application server comprises data selected from the group:

demographic data of the user (col. 6 lines 58-62 and col. 7 lines 62 to col. 8 lines

1), a geographic indicator of the user, a number of products purchased by the

user, currency value of products purchased by the user, a list of products

purchased by the user (col. 8 lines 17 to 21), the tracking code (col. 7 lines 21-35

and Figure 3).

10.   In reference to claim 11, Barnett teaches the merchant server wherein the

pre-conditions are selected from the class: purchase of an item (col. 12 lines 8-

52, col. 13 lines 33-38, and Figure 5), purchase of a quantity of an item (Figure

5), purchase of at least two different items (Figure 3).

11.   In reference to claim 12, Barnett teaches the merchant server wherein the

processor is configured to determine a category of items for display for the client

system (col. 8 lines 14-21 and Figure 10); and configured to request promotions

from the application server in response to the category of items (col. 8 lines 22-

32 and Figure 1).

12.   In reference to claim 13, Barnett teaches the merchant server wherein the

processor is also configured to transmit a plurality of items to the client system

for display (col. 9 lines 34-45), and configured to request promotions from the

application server comprises requesting promotions from the application server in response to the plurality of items (col. 8 lines 22-32 and Figure 1).

13.   In reference to claim 14, Barnett teaches the merchant server wherein the processor is also configured to receive a selection of a trigger item from the client system (col. 12 lines 48-52), and configured to request promotions from the application comprises requesting promotions from the application server in response to the trigger item (col. 12 lines 41-60).

14.   In reference to claim 15, Barnett teaches an application server comprising of: a processor configured to receive an electronic incentive from a central server (col. 4 lines 42-50, col. 6 lines 55-58, col. 8 lines 14-21, and Figure 9), the electronic incentive including a pre-condition and a benefit (Figure 3 and 5); configured to receive a request from a merchant server for electronic incentives (col. 5 lines 3-7 and Figure1); configured to provide a description of the electronic incentive to the merchant server in response to the request, the description including a description of the pre-condition and the benefit (Figure 3, and Figure 1); configured to determine whether the selection of the one item fulfills the pre-condition (col. 7 lines 12-17), and configured to provide the merchant server with the benefit when the selection of the one item fulfills the pre-condition (col. 7 lines 35-44col. 10 lines 47-53); a memory coupled to the processor (col. 4 lines 50-54) configured to store the electronic incentive (col. 4 lines 54-59), and configured to store a record that the electronic incentive has been used (col. 7 lines 12-20 and lines 36-45) , when the selection of the one item fulfills the pre-condition.

15.   In reference to claim 16, Barnett teaches the application server wherein the request from the merchant server also includes a description of a shopping category of a user (col. 12 lines 41-60 and Figure 10).

16.   In reference to claim 17 Barnett teaches the application server wherein the request from the merchant server also includes an indicator of items previously selected by the user or currently displayed to user (col. 12 lines 48-54).

17.   In reference to claim 18, Barnett teaches the application server wherein the pre-condition comprises purchase of the one item (col. 12 lines 8-52, col. 13 lines 33-38, and Figure 5).

18.   In reference to claim 19, Barnett teaches the application server wherein the request from the merchant server also includes an identifier of the user (col. 7 lines 21-34).

19.   In reference to claim 20, Barnett teaches the application server wherein the processor is also configured to forward the record that the electronic incentive has been used to a centralized server (col. 7 lines 36-55).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20.   Claim 21 is rejected under U.S.C. 103(a) as being unpatentable over Barnett et al. in view of official notice. The claim recites the application server

wherein the application server and the merchant server are co-located. In

reference to claim 21, official notice is taken that it is old and well known to co-

locate two servers, since this would involve using less cable for the connection of

the two servers and would hence be more cost effective. Furthermore, co-

locating the application and merchant servers does not alter the steps that are

performed with the two servers when they are not co-located. It would have

been obvious to a person of ordinary skill in the art at the time of the applicant's

invention to include co-location of the application server and the merchant serve

to obtain the above-mentioned advantage.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially

created doctrine grounded in public policy (a policy reflected in the statute) so as

to prevent the unjustified or improper timewise extension of the "right to exclude"

granted by a patent and to prevent possible harassment by multiple assignees.

See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re*

Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164

USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644

(CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may

be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent is shown to

be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

21.   Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No.09/834,855. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims recite a system for promoting products using a world wide web and copending application number 09/834,855 claims recite a method for promoting products using the world wide web. It is obvious that a method needs to be carried out using a system as recited in 09/834,851, and a recitation of such a required system does not does not make the claims of the present application patentable distinct over the claims of the above mentioned copending patent application. Therefore it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to conceive of and include a system with the method for promoting products using a world wide web as recited in this application in order to implement the recited method of the co-pending application.

Conclusion

22.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

a)   Barnett Patent Number 6,336,099. Teaches a method and system for electronic distribution of product redemption coupons.

   b)   Blinn Patent Number 5,999,914. Teaches the use of an electronic

        promotion system for an electronic merchant system.

   c)   Linden Patent Number 6,266,649. Teaches collaborative

        recommendations using item-to-item similarity mappings.

   d)   Sloane Patent Number 5,918,211. Teaches the use of a wireless

        hand-held scanner for making purchases at a retail store that

        issues on the spot promotions as items are scanned.

   e)   Yamashita Patent Number 6,360,206. Teaches an electronic

        shopping system where the discount coupons are provided via the

        Internet, e-mail, or a CD-ROM.

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Namrata (Pinky) Boveja whose telephone

number is 571-272-8105. The examiner can normally be reached on Mon-Fri,

8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax

phone number for the organization where this application or proceeding is
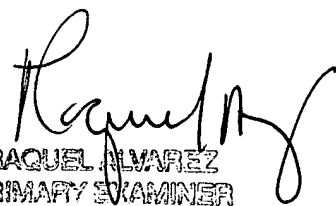
assigned is 571-273-8105.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-

free).

NB

April 19, 2005

RAQUEL ALVAREZ
PRIMARY EXAMINER